

REMARKS

Group I is elected. Claims 29-32 are cancelled without prejudice or disclaimer of the subject matter recited therein. Claims 5-14, 16-26, and new claims 33-34 are pending in the application. Claims 33 and 34 are independent claims.

Claims 33 and 34 are added and are based upon the subject matter of previously cancelled claims 3 and 4. As such, claims 33 and 34 each recite a method of increasing the surface tension of at least one solid object in accordance with elected Group I. Claims 33 and 34, however, each further recite that the test element includes a polyester foil having a surface of an element that can be oxidized with water or an alloy that can be oxidized with water that defines the at least one solid object having a surface. The claims find full support in the specification and particularly at page 2 lines 3-4, page 3 lines 7-8, page 4 lines 5-6 and 11-14, page 5 lines 10-15 and 21-23, page 11 lines 1-15, page 12 lines 3-16 and 28-34, and Example 1, pages 14-17. No new matter is added by virtue of the new claims. Claims 5-14 and 21-26 depend from claim 33 and claims 16-20 depend from claim 34.

The pending claims are rejected under 35 U.S.C. 103 as being unpatentable over USP 4759805 to Saruwatari et al. (col. 1 lines 43-51), USP 3730783 to Steel (col. 2 lines 31-50), USP 3255035 to Clough (col. 3, example 1), or AN 115:237352 in view of McGannon (The Making, Shaping and Treating of Steel, United States Steel).

The rejection is respectfully traversed. Regarding both claims 33 and 34, it is submitted that none of the cited references either alone or in combination with one another disclose or suggest providing at least a portion of an analytical test element including a polyester foil that defines the at least one solid object.

The pending rejection proffers that the claimed analytical test element that is formed to transport liquid from site to site reads on the aluminum conductor as disclosed by Saruwatari (col. 1, lines 15-23, for example). That proffer is respectfully traversed. As discussed above, claims 33 and 34 each recite a polyester foil that defines the at least one solid object. In contrast, Saruwatari et al. discloses an aluminum conductor that is roughened and a hydrophilic film formed on the roughened surface (see the abstract).

Further, the aluminum conductor of Saruwatari is not formed to transport liquid as is required by the present claims, but instead can collect water drops for a certain period

of time. In that regard, the Examiner's attention is directed to col. 1 lines 15-21, where it is taught that water drops from rainfall can collect on the surface because of the presence of oily material adhered to the conductor surface. As such, it is submitted that Saruwatari not only fails to teach or suggest the analytical test element of the present invention, but also teaches away from it.

The Examiner's statement that Saruwatari et al., FR 2100817, Streel, Clough, and AN 115:237352 "do not set forth to increase the surface tension of an object by the oxide coating", is acknowledged. The rejection proffers, however, that McGannon discloses the surface tensions vs. oxides in the same field of endeavor. The proffer is traversed.

Regarding the McGannon reference, it is noted that claims 33 and 34 recite the step of providing at least a portion of an analytical test element including a polyester foil that defines the at least one solid object. In sharp contract to polyester, McGannon discloses the making, shaping and treating of steel. It is submitted that the McGannon reference would not have been available to the inventor at the time the invention was made because McGannon is neither in the field of the claimed endeavor nor is it reasonably pertinent to the specific problem with which the inventors were involved.

McGannon does not contemplate the increasing of a surface tension of a surface of a polyester foil, but instead addresses "surface tensions of some *liquid* metals and some slags". See, p. 317, column 1, fourth paragraph, *emphasis added*. As such, here is no teaching or suggestion in McGannon of an oxide layer/coating creating tension on a solid substrate surface. In that regard, the Examiner's attention is directed to the temperatures given in the figure legends of McGannon. All of the legends of McGannon disclose surface tensions that have been determined at elevated temperatures with molten materials (fig. 12-109, 1570°C; fig. 12-110, 1400°C; fig. 12-111, 1300-1600°C; fig. 12-112, 1500°C, fig. 12-113 silicate melts, and fig. 12-114 liquid iron).

Accordingly, it is submitted that the making, shaping, and treating of steel at such elevated temperatures is not the same field of endeavor as a method of increasing the surface tension a polyester foil of an analytical element formed to transport a sample liquid from a sample application site to a determination site, as recited independently in claims 33 and 34.

Second, it is submitted that McGannon fails to contemplate, let alone suggest an answer to the problem to which the claims pertain. Claims 33 and 34 each relate to increasing the surface tension of a polyester foil defining the at least one solid object of an analytical device, whereby the resulting deposited layer is solid and more hydrophilic than the surface of the solid object.

McGannon neither discloses nor suggest the existence of an analytical element, let alone any problem associated with the hydrophilic nature of its polyester foil component. Instead, McGannon addresses metallurgical problems where "some knowledge of the surface tensions of liquid metals, slags and refractory oxides are needed". See, p. 317, column 1, fourth paragraph. The Examiner's attention is again directed to the above-recited temperatures. One skilled in the art of analytical devices would not be led to turn to the McGannon reference and its disclosure of surface tensions of some liquid metals and some slags to solve issues related to the hydrophilicity of a polyester foil surface of such analytical devices. Accordingly, it is submitted that the disclosure of McGannon is not in the same field of endeavor, as that required by claims 3 and 4.

However, even if McGannon were considered to be the same field of endeavor as the claimed invention, it is submitted that it fails to cure the inadequacies of Saruwatari et al., FR 2100817, Streel, Clough, and AN 115:237352. Specifically, it is submitted that there is no disclosure or suggestion in McGannon regarding oxides and surface tension on a polyester foil of an analytical test element. Further, McGannon fails to contemplate the hydrophilic nature of a solid layer relative to the surface on which it is deposited.

Accordingly, it is respectfully contended that the claimed invention meets the test of patentability under 35 U.S.C. 103(a). Entry of the amendments leading to reconsideration of the rejection of the claims and withdrawal of the rejection is respectfully requested.

The claims are believed to be in condition for allowance, and allowance of the application is respectfully requested. It is requested that if necessary, this paper be

considered a Petition for Extension of time sufficient to effect a timely response, and that all fees due be charged to Deposit Account Number 50-0877 with reference to (RDID 0041 US).

Respectfully submitted,
The Law Office of Jill L. Woodburn, L.L.C.

August 15, 2005
(Date)

Jill L. Woodburn
Jill L. Woodburn
Registration No. 39,874